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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/779,725
Filing Date: February 18, 2004
Appellant(s): GUERET, JEAN-LOUIS

Stephen P. Catlin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 15, 2008 appealing from the Office action mailed December 20, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

397,028	SHAY	1-1889
6,237,609	VASAS	5-2001
5,815,875	YAMADA	10-1998

4,992,575	RIEMANN	5-1990
5,137,038	KINGSFORD	8-1992
3,164,856	SAMARAS	1-1965

STANGE, Dirk DE 296 14 364 U1 Shaving Brush

STANGE, Dirk DE 296 14 364 U1 Shaving Brush (English Translation)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 6, 10-18, 20, 23, 25-27, 30, 34, 37-40, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Stange (DE 296 14 364).

Stange discloses an applicator comprising a base portion (2) carrying an applicator element (4) capable of fixing onto a receptacle (see Figures 1 and 2); and a handle portion (3) rotatably mounted on the base portion to turn about a fixed axis of rotation, wherein the axis of rotation and the longitudinal axis of the handle portion are not mutually perpendicular (see Figures 2 and 3). The handle portion and the base portion cooperate in a manner to enable a user to secure the handle in at least two predefined application positions. The axis of rotation and the longitudinal axis are not

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parallel, and the axis of rotation and an axis of the base are never mutually perpendicular. The base portion and the handle portion co-operate to enable a user to secure the handle portion in at least two predefined position relative to the base (see Figures 2 and 3). The handle portion (12) and the base portion (11) co-operate to produce a click sound (see Figure 2). At least one of the base portion and the handle portion has a relief (5), which allows the base portion and the handle portion to provide a good grip (see Figure 1). The base portion includes a surface that is inclined relative to the axis of the base portion and the axis of rotation extends substantially orthogonally to the inclined surface (see Figure 2). At least one of the base portion and the handle portion includes a pin (9), which is engaged in a housing in the base portion (see Figure 2). The handle portion includes an insert (10) that enables the handle portion to be fixed onto the base portion by snap-fastening (see Figure 2). The applicator includes a stem having a first end which comprises a brush (4) and a second end (see Figure 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 7-18, 20, 23, 25-27, 30-32, 34-40, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vasas (US 6,237,609) in view of Stange.

Vasas discloses an applicator comprising a base portion carrying an applicator element (12) fixed onto a receptacle (10) and a handle portion (26) mounted on the base portion (see Figure 1; column 3, lines 45-55). The handle portion has a longitudinal axis. The base portion comprises a closure cap for the receptacle and the base portion is fixed onto the neck of the receptacle by screwing (see Figure 1; column 3, lines 59-65). The applicator comprises a brush (50) with a non-rectilinear core (see Figure 1; column 4, lines 30-33). The receptacle includes a wiper member (20) arranged to wipe the applicator element while the applicator is being removed (see Figure 1; column 3, lines 45-50). The applicator is configured for applying a product on at least one of the lips, eyelids, eyelashes, eyebrows, and hairs of the user.

Vasas does not disclose the handle portion rotatably mounted on the base portion to turn about a fixed axis of rotation, wherein the axis of rotation and the longitudinal axis of the handle portion are not mutually perpendicular. Stange teaches a base portion (2) carrying an applicator element (4) and a handle portion (3) rotatably mounted on the base portion to turn about a fixed axis of rotation, wherein the axis of rotation and the longitudinal axis of the handle portion are not mutually perpendicular (see Figures 2 and 3). The axis of rotation and the longitudinal axis are not parallel, and the axis of rotation and an axis of the base are not mutually perpendicular. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the base and handle portion of Vasas with the handle portion rotatably

mounted on the base portion to turn about a fixed axis of rotation wherein the axis of rotation and the longitudinal axis of the handle are not mutually perpendicular as taught by Stange to provide the user with an advanced ergonomic handle that allows the user to use multiple angles of tilt while applying a product.

Claims 7-9, 31, 32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stange in view of Shay (US 397,028).

Stange discloses the claimed invention except for the base portion comprising a closure cap for a receptacle, the base portion being arranged to be fixed onto a neck of a receptacle by snap fitting, and the fixing means are leaktight.

Shay teaches the base portion of a shaving brush (4) comprising a closure cap for a receptacle (1). The base portion is arranged to be fixed to the receptacle by screwing and is leaktight (see Figure 2; column 2, lines 65-70). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the shaving brush of Stange to be fixed onto a receptacle as taught by Shay to provide the user with a shaving mug having a convenient means to suspend the brush when not in use.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stange in view of Yamada (U.S. Patent No. 5,815,875).

Stange discloses the claimed invention except for the pin being a split pin. Yamada teaches a split pin which secures a handle to base (see Figure 4 and 5;

column 2, lines 40-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the pin of Stange be a split pin as taught by Yamada in order to allow the pin to fit into the hollow of the base and then lock into place by expanding.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stange.

Stange discloses the base portion including a pin arranged to be snap-fastened into the corresponding opening in the handle portion instead of the handle portion including a pin arranged to be snap-fastened into a corresponding opening in the base portion.

It would have been obvious to one having ordinary skill in the art at the time the invention was made have the handle portion include a pin arranged to be snap-fastened into a corresponding opening in the base portion, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stange in view of Riemann (U.S. Patent No. 4,922,575).

Stange discloses the claimed invention except for the handle portion including fins and a body to which the fins are attached.

Riemann teaches having fins (24b) on a handle portion (see Figure 9; column 1, lines 55-60). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to make the handle portion of Stange with fins as taught by Riemann to provide the mechanical advantage of torque and improved gripping.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stange in view of Kingsford (U.S. Patent No. 5,137,038).

Stange discloses the claimed invention except for the base portion and handle portion including at least one marker and the other base portion and handle portion including an index.

Kingsford teaches having a base portion with an index (6) and a handle portion with a marker (5) (see Figures 1 and 2; column 3, lines 10-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the handle and base of Stange with an index and maker as taught by Kingsford in order to allow the user to move the handle and base to the next position by aligning the maker and index.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stange in view of Samaras et al. (U.S. Patent No. 3,164,856).

Stange discloses the claimed invention except for the applicator element being removable from the base portion.

Samaras et al. teach an interchangeable applicator portion (see Figure 1; column 3, lines 1-10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the applicator portion of Stange be removable as

taught by Samaras et al. in order to allow the user to interchange the brushes in order to allow a different user to use a different applicator.

(10) Response to Argument

With regards to Appellant's argument of the 102(b) rejection of Stange, Appellant argues that Examiner improperly ignores the recited "configured for fixing onto a receptacle" language, and further "configured for" differs from intended use in that it is a positive recitation of structure that facilitates the resultant fixing, Appellant states that Stange is not intended to be fixed and cannot be "fixed" to a receptacle without some additional structure. The "configured for fixing onto a receptacle" language has to be given weight. The mere fact that it can be coupled to a receptacle meets the "configured for" language. In response to Appellant's argument that Stange cannot be "fixed" to a receptacle without some additional structure, a friction fit is considered to be "fixed", therefore, since Stange is capable of being friction fit onto a receptacle it meets the claim limitation. Further it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation, but only requires the ability to so perform. In re Hutchison, 69 USPQ 138.

In response to Appellant's argument that Stange fails to teach or suggest two application positions, page 1 of Stange's English translation states that "The separation of the two grip sections run at an angle of 10 degrees to 60 degrees, preferably 45 degrees to the base of the grip". Therefore, it is understood that although 45 degrees is shown in the drawings and is preferred, the angle can be 10 degrees to 60 degrees. With the angle 10 degrees the axis of rotation and the longitudinal axis of the handle

portion will never be mutually perpendicular. Further noted, a reference is not limited to its preferred embodiment. In re Boe, 148 USPQ 507 (CCPA 1966). Further, Appellant has not clearly defined what an "application position" is, and it is noted a user can use a device according to their own preference. There is nothing precluding the user from using the device in any of the positions as disclosed by Stange.

The Appellant argues in regards to claim 37 that the Office Action fails to make a prima facie case of anticipation because it fails to identify a teaching of the method step of modifying a direction of the base between two different application modes. The "two different application modes" is not defined in claim 37. Further, claim 37 does not require the user to actively apply the device. It merely consists of loading the applicator and turning the applicator element relative to the handle. Stange also discloses loading an applicator and turning the applicator relative to the handle.

With regards to Appellant's argument of the 103(a) rejection of Vasas in view of Stange, Appellant argues that one of ordinary skill in the art would not have had reason to combine Stange and Vasas for the alleged purpose of allowing the "user to use multiple angles of tilt while applying a product" and Stange does not teach a more ergonomic handle. Examiner would like to note that prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art and the prior art reference need not teach or suggest all the claim limitations (MPEP 2141 III). Therefore, one having ordinary skill in the art would have been able to use simple substitution of the handle of Vasas for the handle of Stange to obtain predictable

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results; for instance to allow for a more ergonomic handle. KSR, 550 U.S. at ___, 82 USPQ2d at 1396.

With regards to Appellant's argument of the 103(a) rejection of Stange in view of Shay, Appellant argues that the sealed storage of Shay would prevent drying of the wet shaving brush after usage thus destroying the intended purpose and need for the angled drying position. The device of Shay is used as a storing receptacle. Therefore, once the device of Stange is dry it can then placed in the receptacle. There is no need to place the brush of Stange in the receptacle when it is wet as suggested by Appellant.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Rachel A. Running
/Rachel A. Running/
Examiner, Art Unit 3732

Conferees:
Cris Rodriguez
/Cris L. Rodriguez/
Supervisory Patent Examiner, Art Unit 3732

Thomas Barrett
/Thomas Barrett/
TQAS TC 3700